



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/911,846 | 07/24/2001 | David Pierre Gendron | 1027-003US01 | 3912 |
| 38356 | 7590 | 03/03/2006 | EXAMINER | |
| BROOKS & CAMERON, PLLC 1221 NICOLLET MALL #500 MINNEAPOLIS, MN 55403 | | | BUI, KIM T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3626 | |

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/911,846

Applicant(s)

GENDRON ET AL.

Examiner

Kim T. Bui

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09/28/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 09/06/2005. Claims 1-19 are pending. Claims 3,7,11,12,13,17,18,19 have been amended.

Specification

2. The objection to the disclosure is hereby withdrawn in response to the amendment filed 09/06/2005.

Drawings

3. The objection to the drawings is hereby withdrawn in response to the amendment filed 09/06/2005.

Claim Rejections - 35 USC § 112

4. The rejections of claims 3,8-19 under 35 USC 112, second paragraph is hereby withdrawn in response to the amendment filed 09/06/2005.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2,8-13, 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schnellinger et al. (5642513)

(A) Claims 1, 2, 9, 10 have not been amended. The claims are rejected for the same reasons given in the previous Office Action, dated 06/3/2005, and incorporated herein.

(B) The amendments to claims 8, 11, 12, 13, 18, 19 were apparently made to overcome the rejection under 35 USC 112, second paragraph, and do not change the scope of the claims nor the manner in which the examiner interpreted the claims. As such, claims 8, 11, 12, 13, 18, 19 are rejected for substantially the same reasons given in the previous Office Action, dated 06/03/2005, and incorporated herein.

7. Claims 3, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schnellinger et al. (5642513) as applied to claims 1, 12 above and further in view Pourjavid (5883985).

(A) The amendments to claims 3, 17 were apparently made to overcome the rejection under 35 USC 112, second paragraph, and do not change the scope of the claims nor the manner in which the examiner interpreted the claims. As such, claims 3, 17 are rejected for substantially the same reasons given in the previous Office Action, dated 06/03/2005, and incorporated herein.

8. Claims 6, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schnellinger et al. (5642513) as applied to claims 1, 12 above and further in view De La Huerga (2002/0116509).

(A) Claims 6, 16 have not been amended. The claims are rejected for the same reasons given in the previous Office Action, dated 06/3/2005, and incorporated herein.

9. Claims 4, 5, 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schnellinger et al. (5642513) as applied to claims 1, 12 above and further in view Zandi et al. (6195465).

(A) Claims 4,5,14,15 have not been amended. The claims are rejected for the same reasons given in the previous Office Action, dated 06/3/2005, and incorporated herein.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schnellinger et al. (5642513) as applied to claims 1, 12 above and further in view of Booth et al. (6065073).

(A) The amendments to claim 7 was apparently made to overcome the rejection under 35 USC 112, second paragraph, and do not change the scope of the claim nor the manner in which the examiner interpreted the claim. As such, claim 7 is rejected for substantially the same reasons given in the previous Office Action, dated 06/03/2005, and incorporated herein.

Response to Arguments

11. Applicant's arguments filed 09/06/2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below:

(A) On pages 9-11 of the Remarks, Applicant argues that the *prima facie* case of obviousness, and states that:

“ as provided by the Applicant and as recited in claim 1, the patch data that includes modifications to the medical imaging information:

includes all modifications to the medical imaging information 87B, which was originally generated by the source modality. In other words, the original data is not modified. Rather the asset includes patch dataand the original medical imaging data 87 B (page 25, lines 24 -page 16, line 5).

In contrast, Schnellinger does not teach or suggest what type of security/error checking takes place for the medical images in the MIG, and the *patch data* having modifications to the medical imaging information that was originally generated by the source modality and the revision history including the data and time of the change, and the operator that made the change to the medical imaging information.”

In response, Examiner respectfully submitted the features upon which applicant argues features that are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 1, broadly recites patch data that includes modification to the medical imaging information, This limitation is suggested by Schellinger as discussed in rejection of claim 1 in the previous Office Action, dated 06/03/2005, and incorporated herein.

Dependent claim 6, does recite that patch data includes revise history having data, time, and associated operator. Schellinger does not disclose this, but the concept of keeping a record of modifications including time stamping is well known as suggested by De La Hueraga. Applicant is directed to the rejection of claims 6, 26 in the previous Office action, dated 06/03/2005, and incorporated herein. In response to this argument against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to the Applicant's arguments that Schnellinger does not teach or suggest what type of security/error checking takes place for the medical images in the MIG. The claims do not recite "the types of security/error checking". Claim 1 broadly recites data structure that stores error detection correction information, and this is clearly suggested by Schnellinger as set forth in the rejection of claim 1 in the prior Office Action, dated 06/03/2005, and incorporated herein.

Claim 7 recites "the error detection and correction information comprises a cyclical redundancy check (CRC)". The use of CRC is well known in the art as evidenced by Booth et al (6065073). Applicant is directed to the rejection of claim 7 under the combination of Schnellinger et al and Booth et al set forth in the previous Office Action, dated 06/03/2005, and incorporated herein. Again, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(B) On pages 12-15 of the Remarks, Applicant repeats the argument that Schnellinger does not expressly disclose patch data with revision history, and the references Zandi et al, De la Huerga, Pourjavid, Booth do not cure this deficiency. In response, the Examiner respectfully submitted that the claims 1, 8 broadly recite patch data includes modifications to the medical imaging information, and this broad language is clearly suggested by Schnellinger as discussed in the rejections of claims 1, 8 in the previous Office Action, dated 06/03/2005, and incorporated herein.

In addition, with respect to the Applicant's argument of the *prima facie* case of

obviousness. The Examiner respectfully submits that the rejection set forth in the Office Action dated 06/03/2005 addresses all the limitations of the claims.

It is respectfully submitted that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that she has at least satisfied the burden of presenting a *prima facie* case of obviousness, since she has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See the prior Office Action dated 06/03/2005, and incorporated herein).

The Examiner respectfully notes that each and every claimed limitations are addressed by select portions of the respective reference(s) which specifically support that particular motivation and/or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner. Furthermore, it is respectfully contended that there is no requirement that the motivation to make modifications must

what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In addition, it is respectfully submitted that the issue of obviousness is not determined by what the reference(s) expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Office Action as well as the prior Office Action, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 4/22/93).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. " Telemedicine System" (US 2004/0039606).

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim T. Bui whose telephone number is 571-272-6768. The examiner can normally be reached on Monday-Friday from 8:30A.M. to 5:00P.M..

Art Unit: 3626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

u8
KTB
11/2/05


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER